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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/538,679	03/30/2000	Greg Linden	249768021US	8745

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EXAMINER

MCALLISTER, STEVEN B

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 06/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/538,679

Applicant(s)

LINDEN, GREG

Examiner

Steven B. McAllister

Art Unit

3627

ML

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ____ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36, 56 and 57 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-36, 56 and 57 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Claim Objections

Claim 1 is objected to as based on a disclosure which is not enabling. Assuming that "same" is being given its established meaning of "identical", that the description of the distinguished item and description of the item identified as the same auction fully describe every relevant aspect of their products is critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). Since the method is being called upon to identify an auction for the same item, all aspects of the item must be described. For instance, any description of a bolt might need at least diameter, length, thread, head type, material, coating, etc. If descriptions contained a subset of these aspects, even an apparent perfect correspondence might show dissimilar bolts, for instance bolts with dissimilar lengths or bolts with different thread types.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 1 recites "identifying as an auction offering an item unit that is a unit of the same item as the first unit". Assuming that the claim relies on the established definition of "same" meaning identical, the claim method cannot identify that the item is the same as the one identified. Rather it can only identify an item having a description where the sum of the inverse document frequencies of the selected terms exceeds a threshold. It can only predict similarity based on keywords.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

While applicant may be his or her own lexicographer, a term in a claim may not be given a meaning repugnant to the usual meaning of that term. See *In re Hill*, 161 F.2d 367, 73 USPQ 482 (CCPA 1947). Alternatively, assuming that "same" is not meant to mean identical as discussed above, the term "same" in claim 1 is used by the claim to mean "similar or the same," while the accepted meaning is "resembling in every

relevant respect; conforming in every respect; being one without addition, change, or discontinuance: identical."

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-36, 56 and 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Philips Semiconductors webpage in view of Ishikawa et al (5,848,407) and Sato et al (6,212,517).

Assuming that same means essentially "the same or similar" as argued by the Applicant, Philips shows displaying information about a first sale item including a description; and receiving user input requesting user input for similar items comprising receiving input from the "Find Similar Items" button or receiving input from one of the links listed below the "Find Similar Items" heading. Philips does not show the claimed method for determining similar items. Sato et al show determining for the specified text, the IDF of terms occurring in the text and selecting a plurality of search terms having the largest IDFs and searching the selected keywords. It would have been obvious to one of ordinary skill in the art to modify the method of Philips by performing the steps of Sato et al in order to provide a search tool which provides a measure of item similarity

without requiring additional customer input or manual searching through documents.

Philips further does not show determining which of the terms is in the found item's description and identifying a similar auction where the sum of the IDF's determine the similarity; or displaying information about the item. Ishikawa et al show these steps. It would have been obvious to one of ordinary skill in the art to further modify the method of Philips by determining similar documents by adding the IDF's for the terms in order to provide a simple and efficient means of determining similarity. Finally, Philips does not show sales of items via auction. However, it is notoriously old and well known in the art to sell items via online auction. It would have been obvious to one of ordinary skill in the art to further modify the method of Philips by auctioning items in order to get the highest price.

As to claim 56, Philips in view of Ishikawa et al and Sato et al show displaying information about at least a portion of the found documents.

As to claim 57, Philips in view of Ishikawa et al and Sato et al inherently show comparing the IDF of each term in the description to a minimum threshold comprising the nth lowest IDF where n terms are used as keywords (it is noted that the threshold is not recited as fixed).

As to claim 2, Philips shows a purchasing opportunity at a store displaying information about a first sale item including a description. Philips does not show the specific search method. Sato et al show determining for the specified text, the IDF of

terms occurring in the text and selecting a plurality of search terms having the largest IDF's. It would have been obvious to one of ordinary skill in the art to modify the method of Philips by performing the steps of Sato et al in order to provide a search tool which provides a measure of item similarity without requiring additional customer input.

Philips further does not show performing the search; establishing a score based on summing the term scores of the key words; or displaying information about one or more results. Ishikawa et al show these steps. It would have been obvious to one of ordinary skill in the art to further modify the method of Philips by finding and scoring similar documents by adding the IDF's for the terms in order to provide a simple and efficient means of determining similarity

As to claim 7, it is noted that Philips shows selecting the purchasing opportunities in response to a request from the user.

As to claims 8 and 9, Philips in view of Sato et al and Ishikawa et al show all elements of the claim except selecting the distinguished purchasing opportunity in response to purchase of an item offered therein. However, it is notoriously old and well known in the art to do so. It would have been obvious to one of ordinary skill in the art to further modify the method of Philips by selecting the opportunity in response to a purchase in order to provide information to the buyer about the purchased item.

As to claims 8 and 10, Philips in view of Sato et al and Ishikawa et al show all elements of the claim except selecting the distinguished purchasing opportunity in response to placing of a bid. However, it is notoriously old and well known in the art to do so. It would have been obvious to one of ordinary skill in the art to further modify the

method of Philips by selecting the opportunity in response to a bid in order to provide information to the buyer about the item.

As to claim 11, it is noted that Philips in view of Sato et al and Ishikawa et al show displaying the purchasing opportunity with the highest score.

As to claim 12, Philips in view of Sato et al and Ishikawa et al show all elements of the claim except showing the similar purchasing opportunity in response to a request for information about the distinguished purchasing opportunity. However, it is notoriously old and well known in the art to show a similar item along with the item requested. It would have been obvious to one of ordinary skill in the art to do so in order to present more purchasing opportunities to the buyer and therefore increase the chances of his making a purchase.

As to claim 13, all elements of the claim are shown except listing the purchasing opportunities in order of their scores. However, it is notoriously old and well known in the art to list search results in descending order of relevance or similarity. It would have been obvious to one of ordinary skill in the art to further modify the method of Philips by doing so in order to present the most likely purchase opportunities first.

As to claims 14 and 16, it is noted that Philips in view of Sato et al and Ishikawa et al show all elements except displaying a subset of the opportunities. However, it is notoriously old and well known to display a proper subset of the search results. It would have been obvious to one of ordinary skill in the art to display only a subset in order to fit the information on a standard computer screen with a legible type size.

As to claims 14 and 15, Philips in view of Ishikawa et al and Sato et al show all elements of the claims except showing a number of the subset of the results. However, it is notoriously old and well known in the art to do so (for instance to "1-10 of 25 results"). It would have been obvious to one of ordinary skill in the art to further modify the method of Philips by doing so in order to fit the data on a standard computer screen in a legible way.

As to claim 17, it is noted that Sato et al show selecting a fixed number of keywords.

As to claims 18, it is noted that claimed subject matter is obvious over the claimed step of claim 17. Philips in view of Ishikawa et al and Sato et al show all elements of the claims except determining as keywords a predetermined percentage of the terms in the text. However, it is notoriously old and well known in the art to do so. It would have been obvious to one of ordinary skill in the art to further modify Philips using such a scheme in order to avoid searching terms with a very low IDF (for instance in cases where the text is about the size of the number of keywords chosen).

Alternatively, if it were determined that the claims were patentably distinct over claim 17, a species requirement would be necessary.

As to claim 19, Philips in view of Ishikawa et al and Sato et al inherently show comparing the IDF of each term in the description to a minimum threshold comprising the nth lowest IDF where n terms are used as keywords (it is noted that the threshold is not recited as fixed).

As to claims 20-22, 24, and 26, it is noted that Philips shows these description elements.

Additionally, it is noted that it is old and well known in the art to include any of the elements of claims 20-36 as appropriate for the type of sale and kind of items being sold. It would have been obvious to one of ordinary skill in the art to modify the method of Philips by including such information in order to facilitate ease of purchase.

Response to Arguments

Applicant's arguments filed 1/15/04 have been fully considered but they are not persuasive.

Applicant argue separately that there is no motivation to combine the references. The examiner respectfully disagrees and has noted in the rejection motivation.

Regarding the 112 rejections dealing with the "same" text, the examiner appreciates Applicant's clarification, but still respectfully disagrees and notes his previous comments.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven B. McAllister whose telephone number is (703) 308-7052. The examiner can normally be reached on M-Th 8-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert P. Olszewski can be reached on (703) 308-5183. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Steven B. McAllister